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In the Supreme Court of the United States

OCTOBER TERM, 1976

HENRY B. BRAINERD, PETITIONER

v.

C. MARSHALL DANN, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

WADE H. McCREE, JR.,
Solicitor General,
Department of Justice,
Washington, D.C. 20530.

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Petitioner contends that the Court of Customs and Patent Appeals erred in holding that his method of identifying moving railroad cars was not patentable because it was obvious under 35 U.S.C. 103.

1. Petitioner applied for a patent on a method for sorting railroad cars in railroad yards by destination. Petitioner's claimed invention uses blocks of colored strips on a white background, arranged in patterned combinations to form a binary number code disclosing an alphabetical and numerical identification for each car. The strips are made of "Scotchlite", a retro-reflective material that returns light along an axis, rather than diffusely. A light source directs a beam at the passing cars, and the numbers are "read" by a sensing device that picks up reflections from the patterned blocks (Pet. App. 20-40).

The examiner rejected all six of petitioner's claims and denied the application on the ground that petitioner's invention was obvious in view of the prior art, under 35 U.S.C. 103. That section provides that "[a] patent may not be obtained though the invention is not identically disclosed or described [in prior patents or publications under 35 U.S.C. 102], if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious * * * to a person having ordinary skill in the art to which said subject matter pertains."

The Patent Office's Board of Appeals affirmed the decision of the examiner (Pet. App. 12-16). The Board agreed with the examiner that petitioner's six claims were obvious within the meaning of 35 U.S.C. 103 in view of a known patented system for identifying moving packages (Orthuber (Pet. App. 41-48)), or in view of Orthuber together with a known patented system for identifying moving railroad cars (Kolanowski, *et al.* (Pet. App. 49-68)).

The Board also found that the use of "Scotchlite" would have been obvious to a person of ordinary skill in the art. It noted that two witnesses "in their depositions * * * testified that they considered the use of retro-reflective materials for automatic car identification as an obvious choice." One of the witnesses, the Board noted, had used retro-reflective materials in identifying buses, while the other was a salesman who understood the properties of "Scotchlite" (Pet. App. 14-15). The Court of Customs and Patent Appeals affirmed (Pet. App. 17-19).

2. The Court of Customs and Patent Appeals correctly affirmed the decision of the Board of Appeals. Its decision turns on the facts of this particular record, and is

consistent with this Court's construction of 35 U.S.C. 103. Further review is therefore unwarranted.

The court below did not, as petitioner contends, hold that petitioner's patent claim is obvious on the basis of an unsupported "presumption" that other artisans were aware that "Scotchlite" could be used in an automatic identification system for vehicles (Pet. 2, 6-10). There was ample evidence in the record to indicate what persons of ordinary skill in the art would know. Two witnesses who were highly qualified in the art testified that they considered such a retro-reflective material as "Scotchlite" an obvious choice (Pet. App. 15). Petitioner himself testified to the use of "Scotchlite" in highway signs and safety markers (Pet. App. 17). In the face of such evidence of Scotchlite's obviousness, and the similarity of petitioner's claims to the Orthuber and Kolanowski, *et al.*, patents, petitioner's invention was unpatentable under 35 U.S.C. 103. Cf. *Dann* v. *Johnston*, 425 U.S. 219; *Sakraida* v. *Ag Pro, Inc.*, 425 U.S. 273.[1]

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

WADE H. MCCREE, JR.,
Solicitor General.

JUNE 1977.

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[1]The presently dominant system for car identification, Sylvania's "Kartrack," also uses "Scotchlite" (Pet. 3). The Sylvania system is not identical to petitioner's invention. The Sylvania system has been held not to infringe a patent of petitioner which is the parent patent of that involved here. *Sylvania Electric Products, Inc.* v. *Brainerd*, 369 F. Supp. 468 (D. Mass.), affirmed, 499 F. 2d 111 (C.A. 1).